

REMARKS

Applicant has elected to cancel claims 3, 4, 6, 8, 9, 11, 15, 16, 17, 18, and 19 in this amendment. Applicant is adding new limitations from canceled claim 11 into independent claim 1 and from canceled claim 15 into independent claim 13. Dependent claims 2, 5, 7, 10, 12 and 14 inherently have been amended as they depend on the amended independent claims.

Claims 1, 13, 18-19 were rejected in the recent Office Action under 35 U.S.C. §103(a) as being unpatentable over Kitahara (US Pat. No. 5,723,417). Applicant is adding a new limitation to claims 1 and 13 to overcome this rejection. Kitahara discloses an oil soluble polyester additive to a lubricating oil. Applicant is canceling claims 18 and 19.

Claims 1-10, 13-14, and 16-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kaneko in view of Kitahara. Kaneko teaches a lubricating base oil and a polyalkylene glycol derivative for use in a refrigerating oil composition. Applicant is amending claims 1 and 13 to overcome this rejection. Applicant is canceling claims 16 and 17.

Claims 1-10, 13-14, and 16-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kaneko in view of Sakai. Sakai apparently teaches a poly(alkyl (meth)acrylate polymer as a viscosity improver for lubricating oil. Applicant is amending claims 1 and 13 to overcome this rejection. Applicant is canceling claims 16 and 17.

Claims 1-3, 5, 7-8, 10-15, 13-14, and 17-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kaneko in view of Yagishita. Yagishita apparently teaches viscosity improvers for lubricating compositions, including ethylene-alphaolefin copolymers. Applicant sees several deficiencies in this 35 U.S.C. §103(a) rejection. Kaneko teaches a particular polyalkylene glycol derivative that is particularly effective as a suppressant of wear between aluminum and steel and inhibit clogging of capillary tubes (see first paragraph of summary of invention). Applicant believes that one skilled in the art would interpret the poly(alkylene glycol) derivative of Kaneko to be a viscosity modifier (enhancing the ability of the base oil to lubricate the interface between the aluminum and steel of the compressor. Therefore, there would be no need of a second viscosity modifier in the Kaneko reference and in fact Kaneko would be teaching away from conventional viscosity modifiers in lubricating compressors. In

the second paragraph of the invention, Kaneko says the base oil is synthetic oil. In the list of other additives (column 24, lines 46-55), no mention of viscosity modifiers for synthetic lubricants is mentioned. Irrespective of the lack of teaching in Kaneko of viscosity modifiers for the lubricant of Kaneko, the Examiner chooses to look to Yagishita to choose a hydrocarbon type viscosity modifier overlapping the mist suppressants of Applicant's claims. The Examiner alleges it would be obvious to one skilled in the art to include the viscosity modifiers of Yagashita in the composition of Kaneko. Applicant believes to the contrary that once Kaneko teaches a preferred poly(alkylene glycol) derivative gives improved properties and is the invention, it is conflicting with the Kaneko reference to go a pick a hydrocarbon viscosity modifier as an additive to the Kaneko reference. Applicant also notes that the Yagashita reference used in this rejection was not publicly available when Applicant filed this application (it was published in Dec. 2003 (about 14 months after the priority date of Applicant's current patent filing)). The Yagashita document was published once as a US application but that was contemporaneous with Applicant's filing date.

Applicant includes with this response a petition for a two-month time extension and a Request for Continuing Examination.

Allowance of claims 1, 2, 5, 7, 10, 12, 13 and 14 is respectfully requested.

Applicant authorizes that any deficiency or overpayment of fees or any fees necessary so that this amendment can be considered timely filed and an effective response should be charged or credited to The Lubrizol Corporation Deposit Account No. 12-2275.

Should the Examiner have any questions regarding this amendment or the remarks made herein, a telephone call to the undersigned attorney would be welcome.

Enclosures: Request for a two-month time extension and
Request for Continuing Examination.

Respectfully submitted,
THE LUBRIZOL CORPORATION

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